

**REMARKS**

Claims 12-14, 16-19, 21 and 24 are all the claims pending in the application.

**I. The Rejection Under 35 U.S.C. §112**

Claim 19 is rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Specifically, the Examiner states that the "removal of the requirement for reaction with formalin from [the groups for B<sub>1</sub>: -CONHCH<sub>2</sub>OH, -CONHCH<sub>2</sub>OCH<sub>3</sub>, -CH<sub>2</sub>OCOCH<sub>3</sub>, -C<sub>6</sub>H<sub>3</sub>(OH)CH<sub>2</sub>OH, -C<sub>6</sub>H<sub>3</sub>(OH)CH<sub>2</sub>OCH<sub>3</sub>] sets forth a new genus".

Applicants respectfully submit that the present specification describes the claimed subject matter of claim 19 in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §112, first paragraph, in view of the following remarks.

Applicants respectfully submit that repeating units wherein B<sub>1</sub> represents -CONHCH<sub>2</sub>OH or -CONHCH<sub>2</sub>OCH<sub>3</sub> are supported by the specification as originally filed. The repeating unit wherein B<sub>1</sub> represents -CONHCH<sub>2</sub>OH is shown in Resins (24), (27) and (40) on pages 40 and 57. The repeating unit wherein B<sub>1</sub> represents -CONHCH<sub>2</sub>OCH<sub>3</sub> is shown in Resins (25), (28) and (32) on pages 40 and 41.

The lack of an exact word-for-word basis in the specification is not sufficient to establish a *prima facie* case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 ((Bd.Pat.App.& Inter. 1993). See also In re Johnson and Farnham, 194 USPQ 187 (CCPA

1977). The function of the description requirement of §112, first paragraph, is to ensure that the inventor had possession of, as of the filing date of the application relied upon, the specific subject matter later claimed by him; how the specification accomplishes this is not material. The claimed subject matter need not be described *in haec verba* to satisfy the description requirement. It is not necessary that the application describe the claim limitations exactly, but only so clearly that one having ordinary skill in the pertinent art would recognize from the disclosure that Applicants' invented compositions include those limitations. In re Herschler, 200 USPQ 711, 717 (CCPA 1979).

For the above reasons, it is respectfully submitted that the subject matter of Applicants' claim 19 is fully described in the specification as originally filed and it is requested that the rejection under 35 U.S.C. §112, 1<sup>st</sup> paragraph, be reconsidered and withdrawn.

## **II. Conclusion**

In view of the above, Applicants respectfully submit that their claimed invention is allowable and ask that the rejection under 35 U.S.C. §112 be reconsidered and withdrawn. Applicants respectfully submit that this case is in condition for allowance and allowance is respectfully solicited.

If any points remain at issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local exchange number listed below.

Applicants hereby petition for any extension of time which may be required to maintain the pendency of this case. The USPTO is directed and authorized to charge all required fees,

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLICATION NO. 09/615,708

except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

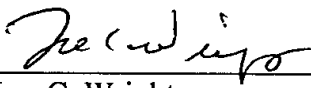
Respectfully submitted,

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

  
\_\_\_\_\_  
Lee C. Wright  
Registration No. 41,441

Date: March 4, 2004